

1 **REMARKS**

2 Brief History:

3 The instant application is a divisional application of U.S. Patent Application  
4 Serial No. 09/992,245, filed November 14, 2001. A preliminary amendment was filed  
5 with the instant application. In the preliminary amendment, claims 1-5 and 15-25  
6 were cancelled.

7 Amendments to the claims:

8 Claims 6 and 7 have been canceled. Accordingly, claims 8 and 10 have each  
9 been amended to be in independent form and to include elements and/or limitations  
10 of claims 6 and 7 from which each of claims 8 and 10 previously depended. Claims  
11 11 and 12 each previously depended from claim 6, and each has been amended to  
12 now depend from claim 8. Claim 14 previously depended directly from claim 6, and  
13 has been amended to be in independent form and to include elements and/or  
14 limitations of claims 6 and 7.

15 Additionally, claims 8 and 9 contain amendments to switch at least one  
16 element and/or limitation relative to those claims. That is, claim 8 now contains at  
17 least one element and/or limitation that was previously contained in claim 9, and  
18 claim 9 contains at least one element and/or limitation that was previously contained  
19 in claim 8. Additional amendments to the terminology of claims 8 and 9 have been  
20 made, which find support at least in figures 8 and 9 of the drawings.

21 Rejection of Claims Under 35 U.S.C. § 102:

22 Claims 6-9, 11, and 12 have been rejected under 35 U.S.C. § 102(b) as being  
23 anticipated by U.S. Patent No. 5,417,642 to Boronka et al. ("Boronka").

24 Claims 6-7, and 11-13, have been rejected under 35 U.S.C. § 102(b) as being  
25 anticipated by U.S. Patent No. 6, 234,947 to Michalik.

Claims 6 and 14 have been rejected under 35 U.S.C. § 102(b) as being  
anticipated by U.S. Patent No. 6,296,601 to Courturier.

The Applicant contends that in view of the amendments to the claims, none of  
the claims are anticipated by the cited art.

In accordance with the generally accepted standard for an anticipation  
rejection, a claim is anticipated only if each and every element as set forth in the

1 claim is found, either expressly or inherently described, in a single prior art  
2 reference. (MPEP 2131.)

3 In regard to claim 8, that claim contains at least the following elements:

4 *a cutting anvil disposed within the second roller and operably moveable from*  
5 *a first position in which the cutting anvil is withdrawn from the elongated slot to a*  
6 *second position in which the anvil is exposed within the elongated slot.*

7 Neither Boronka nor Michalik discloses this element that is required by claim  
8 8. That is, neither Boronka nor Michalik discloses a cutting anvil *disposed within the*  
9 *second roller and operably moveable from a first position in which the cutting anvil is*  
10 *withdrawn from the elongated slot to a second position in which the anvil is exposed*  
11 *within the elongated slot.*

12 Accordingly, the Applicant's claim 8 is not anticipated by either Boronka or  
13 Michalik because neither of those references discloses all of the elements and/or  
14 limitations of that claim. The Applicant therefore respectfully requests that the  
15 rejection of claim 8 be withdrawn and that the claim be allowed.

16 In regard to claims 9 and 11, those claims each depend from claim 8, and  
17 therefore include all of the elements and/or limitations of claim 8. Accordingly, the  
18 Applicant contends that neither of claims 9 and 11 is anticipated by Boronka or  
19 Michalik for the reasons set forth above with respect to the arguments against the  
20 rejection of claim 8. The Applicant therefore respectfully requests that the rejections  
21 of claims 9 and 11 be withdrawn and that those claims be allowed.

22 In regard to claim 12, that claim contains at least the following elements:

23 *a pinch device configured to operably move from a first position away from the*  
24 *media path to a second position proximate the media path to thereby contact a sheet*  
25 *of media moving along the media path from the first roller to the pinch device, and*  
26 *wherein the pinch device is configured to move to the second position to contact the*  
27 *sheet of media at substantially the crease line.*

28 Neither Boronka nor Michalik discloses these elements that are required by  
29 claim 12. Accordingly, claim 12 is not anticipated by either Boronka or Michalik  
30 because neither of those references discloses all of the elements and/or limitations  
31 of that claim. The Applicant therefore respectfully requests that the rejection of  
32 claim 12 be withdrawn and that the claim be allowed.

1 In regard to claim 13, that claim depends from claim 12, and therefore  
2 includes all of the elements and/or limitations of claim 12. Accordingly, the Applicant  
3 contends that claim 13 is not anticipated by either Boronka or Michalik for the  
4 reasons set forth above with respect to the arguments against the rejection of  
5 claim 12. The Applicant therefore respectfully requests that the rejection of claim 13  
6 be withdrawn and that the claim be allowed.

7 In regard to claim 14, that claim previously depended directly from claim 6.  
8 As indicated above, claim 14 was rejected as being anticipated by Courturier. Claim  
9 14 has been amended to be in independent form and to include all of the elements  
10 and/or limitations of both claims 6 and 7. Courturier was not cited in a rejection  
11 against claim 7, and does not anticipate claim 7. Accordingly, claim 14 is not  
12 anticipated by Courturier because claim 14 now contains elements from a claim  
13 (claim 7) which was not rejected by Courturier. That is, the Examiner has not cited a  
14 single prior art reference that contains each and every element and/or limitation as  
15 now set forth in claim 14, as is required for an anticipation rejection.

16 Accordingly, the Applicant respectfully requests that the rejection of claim 14  
17 be withdrawn and that the claim be allowed.

18 Rejection of Claims Under 35 U.S.C. § 103:

19 Claim 10 has been rejected under 35 U.S.C. § 103(a) as being unpatentable  
20 over Boronka. Specifically, the Examiner states that, "Boronka et al. do not disclose  
21 a second knife on the opposing cylinder however the examiner takes OFFICIAL  
22 NOTICE that it would have been obvious to one of ordinary skill in the art to  
23 substitute a second knife for the anvil for cutting the sheet material."

24 The Applicant notes that the Examiner "may take official notice of facts  
25 outside of the record which are capable of instant and unquestionable demonstration  
as being 'well-known' in the art." (MPEP 2144.03.)

The Applicant contends, however, that to "*substitute a second knife for the  
anvil for cutting the sheet material*" is not capable of instant and unquestionable  
demonstration of being "well-known" in the art. That is, the Applicant hereby  
traverses the assertion made by the Examiner under official notice in the rejection of  
claim 10.

1 According to the MPEP, if the Applicant traverses an assertion of official  
2 notice by the Examiner, the Examiner must then cite a reference in support of the  
3 Examiner's position. (Id.)

4 Furthermore, the Applicant notes that, "there must be some suggestion or  
5 motivation, either in the references themselves or in the knowledge generally  
6 available to one of ordinary skill in the art, to modify or combine reference  
7 teachings." (MPEP 2145(X)(C).)

8 Moreover, "[i]f proposed modification would render the prior art invention  
9 being modified unsatisfactory for its intended purpose, then there is no suggestion or  
10 motivation to make the proposed modification." (MPEP 2143.01.)

11 The Applicant contends that *substituting a second knife for the anvil of*  
12 *Boronka* would render the apparatus of Boronka unsatisfactory for the intended  
13 purpose of folding sheet material, or for the purpose of cutting sheet material.  
14 Specifically, if the folding anvil of Boronka were replaced by a knife, the resulting  
15 apparatus would include only two rollers, each having a knife. That is, no anvil  
16 would be included in the apparatus of Boronka if the modification proposed by the  
17 Examiner was made. However, the anvil of Boronka is required in order to render  
18 the apparatus of Boronka functional to fold sheet material.

19 The Applicant notes further that, "proceeding contrary to accepted wisdom in  
20 the art is evidence of nonobviousness." (MPEP 2145(X)(D)(3).)

21 The Applicant contends that the accepted wisdom of the art, as indicated by  
22 the cited prior art, is to include only a single knife in only one of a pair of rollers for  
23 folding or cutting sheet material. That is, the accepted wisdom of the art, as  
24 indicated by the cited prior art, is to not include more than one knife in a pair of  
25 rollers for folding or cutting sheet material.

For at least the reasons set forth above, the Applicant contends that the  
Examiner has not established a *prima facie* case of obviousness in regard to  
claim 10. Accordingly, the Applicant respectfully requests that the rejection of claim  
10 be withdrawn and that the claim be allowed.

In the alternative, the Applicant contends that the above traverse by the  
Applicant of the Examiner's assertion of Official Notice is a seasonable challenge  
and constitutes a demand for evidence made as soon as practicable during  
prosecution, in accordance with the requirements set forth in MPEP §2144.03.

1 New Claims:

2 Claims 26-37 have been added as indicated herein above. Support for the  
3 new claims is found in the specification and drawing figures. No new matter has  
4 been added.

5 Fee:

6 A fee for additional claims is to be charged to the Assignee's deposit account  
7 as set forth in the attached Transmittal Letter For Response/Amendment.

8 **SUMMARY**

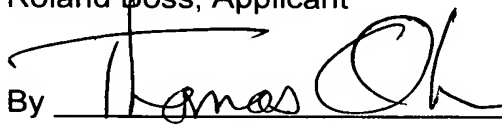
9 The Applicant believes that this communication constitutes a full and complete  
10 response to the Office action mailed 09/08/2004. The Applicant respectfully  
11 requests withdrawal of rejections of claims 8-14, and timely allowance of claims 8-14  
12 and 26-37.

13 The Examiner is respectfully requested to contact the below-signed  
14 representative if the Examiner believes this will facilitate prosecution toward  
15 allowance of the claims.

16 Respectfully submitted,  
17 Roland Boss, Applicant

18 Date: December 08, 2004

19 By



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